

REMARKS/ARGUMENTS

Claims 1-7, 74-79, 81, 84-100, 102, 107, 109-111, 116-120, 122, 126, 127, 129, 130, 132-169, 171-197, 199-237, 272, 274, and 275 are pending in the present application. Claims 74, 81, 84, 116-118, 130, 142-144, 150, and 191 have been amended. Claims 80, 82, 83, 112-115, 121, 123-125, 128, and 131 have been canceled. Re-examination and re-consideration of the pending claims are respectfully requested.

As an initial matter, Applicants respectfully request that the Information Disclosure Statement filed February 23, 2005 be acknowledged and that the references disclosed therein be considered.

Applicants note with appreciation the allowance of claims 1-3. Applicants believe withdrawn dependent claims 4-7 and previously added dependent claims 274 and 275 also stand in condition for allowance as they depend upon allowable independent claim 1.

The remaining claims have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,663,662 issued to Pacetti et al. Applicants are confused by the Examiner's application of the Pacetti et al. reference. First, the Pacetti et al. patent is inapplicable 102(e) prior art to the present invention as explained below. Secondly, the Examiner cites to figures 7-12, yet there are no such figures in the Pacetti et al. reference. Lastly, the Examiner references the Ragheb reference (USPN 5,873,904), which was already addressed in the previously filed response on August 8, 2005. Hence, this rejection is respectfully traversed.

With respect to the rejection of independent claim 74 (and the claims which depend thereon), Applicants note the Pacetti et al. reference is not prior art to this subset of claims. The Pacetti et al. patent has an effective filing date of **December 28, 2000**. The present application is a continuation-in-part of and claims priority from parent Provisional Application Serial No. 60/258,024, filed on **December 22, 2000**. Applicants believe that claim 74 (which

has now been amended to include the limitations of dependent claims 112 and 125 so as to further expedite prosecution and more clearly claim the present invention) and the claims dependent thereon are fully supported under 35 U.S.C. § 112 in the '024 parent application. Hence, the present application with respect to amended claim 74 (and the claims dependent thereon) has an effective filing date of December 22, 2000. Under M.P.E.P. § 706.02, the Pacetti et al. reference does not appear to be 102(e) prior art to this claim subset, and as such, Applicants respectfully request that the anticipation rejection be withdrawn and claim 74 (and the claims dependent thereon) be allowed.

With respect to remaining independent claim 150, it recites a device for intracorporeal use comprising an expandable stent member and at least one source of at least one therapeutic capable agent disposed adjacent at least one of the luminal or tissue facing surfaces of the stent member. In particular, the device is configured to release the therapeutic capable agent at a phase to a susceptible tissue site of a mammalian intracorporeal body *to effectuate a mammalian tissue concentration ranging from about 0.001 ng of therapeutic capable agent / mg of tissue to about 100 µg of therapeutic capable agent / mg of tissue so as to inhibit restenosis.*

As the Examiner certainly knows and appreciates, a single cited art reference must teach each and every element of the claim to establish anticipation under 35 U.S.C. § 102. M.P.E.P. § 2131. The Court of Appeals for the Federal Circuit has held that, "the identical invention must be shown in as complete detail as is contained in the claims." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

In the instant case, the Pacetti et al. reference fails to teach or suggest any mammalian tissue concentrations, much less the specific range claimed of 0.001 ng of therapeutic capable agent / mg of tissue to about 100 µg of therapeutic capable agent / mg of tissue so as to inhibit restenosis. Applicants request if the present rejection is maintained, the Examiner show or explain where the Pacetti et al. reference teaches or suggests this specific tissue concentration range. Absent a showing in the cited art of record, Applicants request the

Appl. No. 10/002,595
Amdt. dated March 6, 2006
Reply to Office Action of December 13, 2005

PATENT

withdrawal of this rejection and allowance of independent claim 150 (and the claims which depend therefrom).

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Nena Bains
Reg. No. 47,400

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300

NB:deb
60685547 v1